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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,377	07/24/2003	Steven H. Marquardt	4676-00004	2505
7590	10/14/2004		EXAMINER	MEISLIN, DEBRA S
			ART UNIT	PAPER NUMBER
			3723	
			DATE MAILED: 10/14/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/626,377	MARQUARDT, STEVEN H.
	Examiner Debra S Meislin	Art Unit 3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 26 and 37-41 is/are pending in the application.
 - 4a) Of the above claim(s) 38-41 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 26 and 37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

1. Newly submitted claims 38-41 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 38-41 are directed to patentably distinct species from claims 26 and 37. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38-41 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtiss (4287795) in view of McCann (6216565).

Curtiss discloses all of the claimed subject matter except for the torque transmitting element passing through at least one of the rotatable elements and providing a retaining element engageable with the torque transmitting element to secure the interlocked tool housings together. Note that Curtiss discloses a torque transmitting element (32) extending into at least one of the rotatable elements and a retaining element (56L and 56R) to secure the interlocked tool housings together. Curtiss additionally discloses “universally engageable” mating interlocking configurations as broadly claimed by applicant.

McCann discloses a torque transmitting element (50) passing through at least one of the elements and providing a retaining element (54) engageable with the torque transmitting element (50) to secure the interlocked tool elements together. It would have been obvious to one having ordinary skill in the art to form the torque transmitting element of Curtiss such that it passes through at least one of the rotatable elements and to form the retaining element of Curtiss as engageable with the torque transmitting element to secure the interlocked tool elements together as taught by McCann.

McCann additionally discloses the use of a “universally engageable” mating interlocking configuration between elements “32” and “14”.

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Applicant's arguments filed July 6, 2004 have been fully considered but they are not persuasive.

Curtiss additionally discloses "universally engageable" mating interlocking configurations as broadly claimed by applicant. The claims define "at least two tools". Curtiss discloses "at least two tools" which includes a first tool "12" and a second tool "40". The first tool "12" and a second tool "40" each have a "universally engageable" mating interlocking configuration since the tools are engageable with each other. Applicant's claims and/or specification do not define the term "universally engageable". Applicant has not set forth to what element(s) the mating interlocking configurations are universal? Since the scope of the claims provide for two tool elements, it is asserted that the Curtiss reference discloses the "universally engageable" mating interlocking configurations as claimed.

McCann was not applied to the rejection of the claims to disclose all of the claimed subject matter. McCann was also not applied to the rejection of the claims to disclose the subject matter disclosed by the Curtiss reference. McCann was applied to the rejection of the claims to teach only the concept of providing a torque transmitting element (50) passing through at least one of the elements and providing a retaining element (54) engageable with the torque transmitting element (50) to secure the interlocked tool elements together.

In response to applicant's argument that the combination of Curtiss and the teachings of McCann would impair the intended function of Curtiss, the test for

obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant contends that Curtiss does not disclose a "second rotatable element for tool 12". Applicant's arguments are not on point since they are not supported by the claims.

Applicant's arguments with respect to the additional elements shown by the Curtiss reference are not on point since the claims do not preclude the use of additional elements. The claimed subject matter, as written, is disclosed by the applied references.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 703 308-3671. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3723



Debra S Meislin
Primary Examiner
Art Unit 3723

October 13, 2004